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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BENNETT M. RICHARD and JOHN T. BROOME

Appeal 2008-1084
Application 10/695,205
Technology Center 3700

Decided: October 31, 2008

Before WILLIAM F. PATE, III, JENNIFER D. BAHR, and JOSEPH A.
FISCHETTI, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Bennett M. Richard and John T. Broome (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1, 2, 4-7, 9, and 12-14. Claims 10, 11, and 15-17 have been indicated allowable. Claim 8 was canceled subsequent to the Final Rejection. No other claims are

pending. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002). Appellants' representative presented oral argument on October 23, 2008.

Appellants' claimed invention is directed to a method of manufacturing screen assemblies for downhole use, the method of manufacturing involving expansion of the base pipe to attach the filtration material thereto (Specification ¶ 1). Independent claim 1, reproduced below, is representative of the claimed invention.

1. A method of manufacturing a screen for downhole use, comprising:
 - inserting a base pipe into a filter layer;
 - securing said filter layer to said base pipe by expanding said base pipe.

At issue is whether the Examiner erred in rejecting claims 1, 2, 4-7, and 9¹ under 35 U.S.C. § 102(e) as anticipated by Echols (US 6,941,652 B2, issued Sep. 13, 2005) and claims 12-14 under 35 U.S.C. § 103(a) as unpatentable over Echols. This issue turns on whether Echols teaches a step of securing the filter layer to the base pipe by expanding the base pipe as part of the method of manufacturing the screen assembly.

¹Although we find no clear explanation by the Examiner to this effect on the record, it appears that the arguments by Appellants and the amendments made to claims 5 and 9 subsequent to the Final Rejection (see Amendment filed Oct. 31, 2006) were sufficient to overcome the rejections under 35 U.S.C. § 112, but resulted in claims 5 and 9 becoming subject to the rejection under 35 U.S.C. § 102(e). In light of Appellants' statement on page 2 of their Appeal Brief that claims 1, 2, 4-7, 9, and 12-14 are involved in this appeal, we treat Appellants' arguments against the anticipation rejection as directed to claims 1, 2, 4-7, and 9.

OPINION

Echols teaches a method of fabricating an expandable thin-wall well screen assembly. The well screen 36 includes a generally tubular base pipe 38, a generally tubular multi-layer filter media sheet 40, and a generally tubular protective outer shroud 42 (col. 4, ll. 35-37). Echols teaches fabricating the well screen by: securing a stack 40*a* of metal mesh sheets of filter media structure to one another and to a rectangular metal plate 42*a* that will form the shroud 42 using a suitable diffusion bonding process (col. 5, l. 55 to col. 6, l. 9); deforming the shroud 42 with attached filter media structure 40 to a tubular configuration and seam welding the abutting side edge portions to retain the shroud and filter media structure in their tubular configurations (col. 6, ll. 22-32); telescoping a tubular base pipe 38 into the interior of the shroud 42, thereby sandwiching the filter media 40 between the base pipe 38 and shroud 42 (col. 6, ll. 34-37); and anchoring the filter media-lined shroud 42 to the base pipe 38, such as by annular welds 58 extending around opposite ends of the shroud 42 (col. 6, ll. 38-41). The anchoring step secures both the shroud and the filter media attached to the shroud to the base pipe. Echols' method of fabricating the well screen does *not* include a step of securing the filter layer to the base pipe by expanding the base pipe, as required by claim 1. Rather, the step of expanding the base pipe discussed by Echols (col. 3, ll. 38-45; col. 5, ll. 1-4; and col. 6, ll. 49-56) is performed downhole as part of a method of using the already fabricated well screen.

Appellants' claim 1 is directed to a method of *manufacturing* a screen, not to a method of using a screen, and requires, as part of the method

of manufacturing, a step of securing the filter layer to the base pipe by expanding the base pipe.

To establish anticipation, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001). As shown by our findings above, Echols lacks, in the method of manufacturing a screen, a step of securing the filter layer to the base pipe by expanding the base pipe, as required in claim 1. Accordingly, the rejection of claim 1, and claims 2, 4-7, and 9 depending from claim 1, as anticipated by Echols cannot be sustained.

The Examiner's rejection of claims 12-14 under 35 U.S.C. § 103(a) as unpatentable over Echols is grounded in part on the Examiner's flawed determination that Echols teaches a method of manufacturing a screen including a step of securing the filter layer to the base pipe by expanding the base pipe. Accordingly, this rejection also cannot be sustained.

CONCLUSIONS

The Examiner erred in rejecting claims 1, 2, 4-7, and 9 under 35 U.S.C. § 102(e) as anticipated by Echols and claims 12-14 under 35 U.S.C. § 103(a) as unpatentable over Echols, because Echols does not teach a step of securing the filter layer to the base pipe by expanding the base pipe as part of the method of manufacturing the screen assembly, as called for in the claims.

DECISION

The decision of the Examiner to reject claims 1, 2, 4-7, 9, and 12-14 is reversed.

REVERSED

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